

## **REMARKS**

### **I. INTRODUCTION**

With the cancellation without prejudice of claim 5, and the addition of claims 6 to 14, claims 1 to 4 and 6 to 14 are now pending. Reconsideration of the present application in view of the foregoing amendments and following remarks is respectfully requested.

### **II. OBJECTION TO THE DRAWINGS**

The drawings were objected to under 37 C.F.R. § 1.84 (h)(3) for alleged improper cross hatching. In particular, the Office Action asserts that all parts shown in section must be cross-hatched and that cross-hatching patterns should be selected from those shown on page 600-114/115 of the M.P.E.P. based on the material part. In this regard, Figs. 1 and 2 have been amended herewith so that all parts shown in section are indicated in hatching. No new matter has been added. Entry and approval of amended Figs. 1 and 2 are respectfully requested. It is respectfully submitted that the drawings comply with 37 C.F.R. § 1.84 (h)(3). In this regard, it is respectfully noted that 37 C.F.R. § 1.84 (h)(3) merely states that “[d]ifferent types of hatching should have different conventional meanings as regards the nature of a material seen in cross section” (emphasis added) but does not require that the hatching must have conventional meanings or be selected from those shown on page 600-114/115 of the M.P.E.P. Accordingly, withdrawal of the objection to the drawings with respect to Figs. 1 and 2 is respectfully requested.

The drawings were also objected to for an asserted lack of description in the Specification regarding the two areas marked “A” and “B” in Fig. 3. In this regard, the Specification has been amended to better clarify the subject matter with respect to the two areas marked as “A” and “B”. No new matter has been added. Entry and approval are respectfully requested. Accordingly, withdrawal of the objection to the drawings with respect Fig. 3 is respectfully requested.

### **III. OBJECTION TO CLAIM 1**

With respect to the objection to claim 1 for certain informatities, claim 1 has been amended herein as suggested by the Examiner. Withdrawal of the objection to claim 1 is therefore respectfully requested.

### **AMENDMENTS TO THE DRAWINGS**

The attached sheet of drawings includes changes to Figs. 1 and 2. In particular, Figs. 1 and 2 have been amended to include a proper hatching.

#### **IV. REJECTION OF CLAIMS 1 AND 4 UNDER 35 U.S.C. § 102(b)**

Claims 1 and 4 stand rejected under 35 U.S.C. § 102(b) as anticipated by Japanese Patent Publication No. 02-17289 ("Kawakami").

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102, the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (See *Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (See *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

While the rejections may not be agreed with, to facilitate matters, claim 1 has been revised to include the features of canceled claim 5. It is respectfully submitted that Kawakami does not identically describe (or even suggest) the features of canceled claim 5 and therefore does not anticipate claim 1 as presented, or claims that depend from claim 1, including claim 4. Withdrawal of the anticipation rejections with respect to Kawakami is therefore respectfully requested.

#### **V. REJECTION OF CLAIMS 2 AND 3 UNDER 35 U.S.C. § 103(a)**

Claims 2 and 3 were rejected under 35 U.S.C. § 103(a) as unpatentable over Kawakami in view of U.S. Patent No. 5,350,228 ("Remington").

With respect to the rejection of claims 2 and 3 under 35 U.S.C. § 103(a) as unpatentable over Kawakami in view of Remington, it is respectfully submitted that even if it were proper to combine the references as suggested (which is not conceded), the secondary Remington reference does not cure the critical deficiencies of the Kawakami reference (as explained above) with respect to claim 1, from which claims 2 and 3 depend. Indeed, the Office Action does not allege that Remington cures the deficiencies of Kawakami as applied against claim 1. It is therefore respectfully submitted that claims 2 and 3 are allowable for at least the same reasons that claim 1 is allowable. Accordingly, withdrawal of the obviousness rejection of claims 2 and 3 is respectfully requested.

## **VI. REJECTION OF CLAIM 5 UNDER 35 U.S.C. § 102(b)**

Claim 5 was rejected under 35 U.S.C. § 103(a) as unpatentable over Kawakami in view of U.S. Patent No. 5,436,803 ("Annis") and U.S. Patent No. 5,245,613 ("Takami").

To reject a claim as obvious under 35 U.S.C. § 103, the prior art must disclose or suggest each claim feature and it must also provide a motivation or suggestion for combining the features in the manner contemplated by the claim. (See Northern Telecom, Inc. v. Datapoint Corp., 908 F.2d 931, 934 (Fed. Cir. 1990), cert. denied, 111 S. Ct. 296 (1990); In re Bond, 910 F.2d 831, 834 (Fed. Cir. 1990)).

The features of canceled claim 5 have been included in claim 1, as explained above.

As discussed above, the primary Kawakami reference does not in any way disclose or suggest the features of claim 1 as presented. It is also respectfully submitted that the Annis and Takami references do not disclose an electrostatic discharge device (ESD) safe wireless type of component, as provided for in the context of claim 1 as presented, in which a dissipative coating layer is applied onto all connecting cables of ESD sensitive devices. This is evidenced by the fact that the Office Action does not in any way identify the foregoing features in either Annis or Takami. Instead, the Office Action merely asserts on page 4 that "Annis et al., discloses conductive wires connected to a circuit board" and "Takami et al., disclose cable 17 connected to motherboard", without regard to a dissipative coating layer. Indeed, any review of Annis and Takami makes plain that these references simply do not cure the critical deficiencies of the Kawakami reference with respect to the features of claim 1 discussed above. It is therefore respectfully submitted that claim 1 is allowable over the references as applied.

The Office Action also asserts that "[a] person of ordinary skill in the art would recognize the advantage of providing antistatic coating to cable connection to have protection against static electricity during the manufacturing process/assembly or during use of the device" and "[t]herefore, it would have been obvious to a person of ordinary skill in the art at the time of applicant's invention to provide connecting cables to the board of Kawakami et al., for input/output signal of various devices ... and to coat those cable connections with the dissipative coating", but such assertions are clearly suggestions on the part of the Examiner alone with no supportive basis in the references cited.

In this regard, to the extent that the Examiner maintains the unsupported “ordinary skill” statements regarding those rejections, it is respectfully requested pursuant to 37 C.F.R. § 1.104(d)(2) that the Examiner provide an affidavit and/or that the Examiner provide published information concerning these assertions. This is because the § 103 rejections are apparently being based on assertions that draw on facts within the personal knowledge of the Examiner, since no support was provided for these otherwise conclusory and unsupported assertions. (See also M.P.E.P. § 2144.03). Otherwise, if the Examiner cannot provide either references or an affidavit to support the contentions now made, it is respectfully requested that the rejections of the claims under 35 U.S.C. § 103(a) be withdrawn for this reason alone.

The cases of In re Fine, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988), and In re Jones, 21 U.S.P.Q.2d 1941 (Fed. Cir. 1992), also make plain that the Office Action's generalized assertions that it would have been obvious to modify the references relied upon do not properly support a § 103 rejection. It is respectfully suggested that those cases make plain that the Office Action reflects a subjective “obvious to try” standard, and therefore does not reflect the proper evidence to support an obviousness rejection based on the references relied upon. In particular, the Court in the case of In re Fine stated that:

Instead, the Examiner relies on hindsight in reaching his obviousness determination. . . . **One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.**

In re Fine, 5 U.S.P.Q.2d at 1600 (citations omitted; emphasis added). Likewise, the Court in the case of In re Jones stated that:

Before the PTO may combine the disclosures of two or more prior art references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. . . .

**Conspicuously missing from this record is any evidence, other than the PTO's speculation (if it be called evidence) that one of ordinary skill . . . would have been motivated to make the modifications . . . necessary to arrive at the claimed [invention].**

In re Jones, 21 U.S.P.Q.2d at 1943 & 1944 (citations omitted; italics in original).

• That is exactly the case here since the present Office Action offers no evidence whatsoever, but only conclusory hindsight, reconstruction and speculation, which these cases have indicated does not constitute evidence that will support a proper obviousness finding. Unsupported assertions are not evidence as to why a person having ordinary skill in the art would be motivated to modify a reference in view of another reference to provide the claimed subject matter of the claims. Accordingly, the Office Action's assertions in this regard are simply insufficient since the Office must provide proper evidence of a motivation or suggestion for modifying a reference in view of another reference to provide the claimed subject matter.

In short, there is no evidence whatsoever — except subjective speculation — that the references relied upon, whether taken alone, combined or modified, would provide the features discussed above of any of claim 1 as presented. It is therefore respectfully submitted that claim 1 is allowable for these further reasons.

In sum, it is therefore respectfully submitted that claim 1 as presented, and claims that depend from claim 1, are allowable over the applied references for at least these reasons. Accordingly, the obviousness rejections of these claims should be withdrawn.

## **VII. NEW CLAIMS 6 TO 14**

New claims 6 to 14 do not add any new matter and are supported by the present application, including the specification. Claims 6 to 14 depend either directly or indirectly from claim 1 and therefore are allowable for at least the same reasons as claim 1.

### **CONCLUSION**

In view of the foregoing, it is respectfully submitted that all of the presently pending claims are allowable. It is therefore respectfully requested that the rejections be withdrawn since they have been obviated. All issues raised by the Examiner having been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,

KENYON & KENYON

Dated: 3/7/05

By: *Dervis Magistre*  
Dervis Magistre  
Reg. No. 41,172

One Broadway  
New York, NY 10004  
(212) 425-7200

**CUSTOMER NO. 26646**